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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/436,749	11/09/1999	JAMES R. WALKER	490334-016	7092

30074 7590 09/26/2003

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[REDACTED] EXAMINER

YUAN, ALMARI ROMERO

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

2176

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

CS

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/436,749	WALKER, JAMES R.
	Examiner Almari Yuan	Art Unit 2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 July 2002.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4, 6, 8,</u><br><u>and 11.</u> | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. This action is responsive to communications: Application filed on 11/09/99 and IDSs filed on 2/11/00, 3/15/01, 9/20/00, and 7/11/02.
2. Claims 1-15 are pending in the case. Claims 1, 5, 7, 8, 9, 12, and 13 are independent claims.

***Specification***

3. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-13, 15, 17, and 19 of Gauthier et al., U.S. Patent

No. 6,209,010 B1 (hereinafter Gauthier). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

**Regarding independent claim 1,** Gauthier claim 11 teaches monitoring text string defined by a text command in the page description language specification for a special character or special string of characters (see Gauthier claims 11; compare with pending claim 1); responsive to a detection of the special character or the special string of characters in the text string, identifying the path defined by the page description language path command and having predetermined relationship with the text command in the specification as the particular path (see Gauthier claim 11; compare with pending claim 1).

Gauthier does not teach first and second text string, first and second page description language, first and second special characters, and first and second string of character. It would have been obvious to one of ordinary skill in the art at the time the invention to implement “text string defined by a text command in the page description language specification for a special character or special string of characters” of Gauthier as “first and second text string defined by a first and second page description language text command in the specification for a first and second special character or first and second special string of characters” of the instant application because “text string defined by a text command in the page description language specification for a special character or special string of characters” is a narrower limitation. As such, by eliminating “text string defined by a text command in the page description language specification for a special character or special string of characters” from the claim language, and relying instead on “first and second text string defined by a first and second page description language

text command in the specification for a first and second special character or first and second special string of characters”, a much narrower limitation, applicant has in effect eliminated an elements from the claim. The courts have determined that elimination of element renders the claim obvious. See In re Karlson, 136, USPQ 184 (CCPA 1963); In re Wilson, 153 USPQ 740 (CCPA 1967); Ex parte Rainu, 168 USPQ 375 (PTO Bd. Of App. 1969).

Gauthier does not explicitly teach special attribute within claim 11. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, because an attribute within Gauthier in a PDL environment suggests attribute as special characters or string of characters.

**Regarding dependent claim 2**, Gauthier claim 12 teaches predetermined relationship is satisfied by the path command being the first path command to follow the text command in the specification (see Gauthier claim 12; compare with pending claim 2).

**Regarding dependent claim 3**, Gauthier claim 13 teaches predetermined relationship is satisfied by the path command being grouped with the text command in the specification (see Gauthier claim 13; compare with pending claim 3).

**Regarding dependent claim 4**, Gauthier claims 17 and 19 teaches special attribute is associated with a first merge file and wherein the second special attribute is associated with a second merge file. Gauthier claim 17 teaches a merge file containing plurality of blocks of text and claim 19 teaches applying the attribute to the block of text (see Gauthier claims 17 and 19; compare with pending claim 4).

**Regarding independent claim 5**, Gauthier claims 15 and 19 teaches designating a path defined in a page description language specification as a wrapping path, the wrapping path

having a wrapping-path boundary; processing the specification to produce a template bitmap, the template bitmap being a bitmap or raster-data representation of a template image defined in the specification; merging bitmap representations of the text from the block of text, according to the boundary and according to a predefined flow rule, in the template bitmap to create a merged bitmap (see Gauthier claim 15; compare with pending claim 5);

associating a block of text with the wrapping path (see Gauthier claim 19; compare with pending claim 5).

Gauthier does not explicitly teach an external bitmap and external-bitmap boundary. However, these limitations would have been obvious to one of ordinary skill in the art at the time of the invention, because an external bitmap and external-bitmap boundary within Gauthier PDL environment suggests the bitmap is external to the specification.

Gauthier does not explicitly teach composite boundary. It would have been obvious to one of ordinary skill in the art at the time the invention to implement “merging bitmap representations of the text from the block of text, according to the boundary” of Gauthier as “merging bitmap representations of the text from the block of text, according to the composite boundary” of the instant application because “merging bitmap representations of the text from the block of text, according to the boundary ” is a narrower limitation. As such, by eliminating “merging bitmap representations of the text from the block of text, according to the boundary” from the claim language, and relying instead on “merging bitmap representations of the text from the block of text, according to the composite boundary”, a much narrower limitation, applicant has in effect eliminated elements from the claim. The courts have determined that elimination of

element renders the claim obvious. See In re Karlson, 136, USPQ 184 (CCPA 1963); In re Wilson, 153 USPQ 740 (CCPA 1967); Ex parte Rainu, 168 USPQ 375 (PTO Bd. Of App. 1969).

**Regarding dependent claim 6**, Gauthier claim 15 teaches merging the external bitmap in to the template bitmap according to the wrapping-path boundary and according to the predefined flow rule (see Gauthier claim 15; compare with pending claim 6).

**Regarding independent claim 7**, Gauthier claim 15 teaches designating a path defined in a page description language specification as a wrapping path, the wrapping page having a boundary; defining graphics state for the path; processing the specification to produce a template bitmap, the template bitmap being a bitmap or raster-data representation of a template image defined by the specification; associating a text file with the wrapping path, the text file including a first block of text separated from a second block of text; creating bitmap representation of the block of text by applying graphics state to the block of text; merging the bitmap representation of the text, according to the boundary and according to the predefined flow rule, into the template bitmap (see Gauthier claim 15; compare with pending claim 7).

Gauthier does not explicitly teach field delimiter. However, this element would have been obvious to one of ordinary skill in the art at the time of the invention, because a field delimiter within Gauthier PDL environment suggests separating characters with a space, tab, new line as field delimiters.

Gauthier does not explicitly teach first and second graphics state, first and second block of text, and first and second bitmap representation. It would have been obvious to one of ordinary skill in the art at the time the invention to implement “graphic state, block of text, and bitmap representation” of Gauthier as “first and second graphics state, first and second block of

text, and first and second bitmap representation" of the instant application because "graphic state, block of text, and bitmap representation" are a narrower elements. As such, by eliminating "graphic state, block of text, and bitmap representation", and relying instead on "first and second graphics state, first and second block of text, and first and second bitmap representation", a much narrower limitation, applicant has in effect eliminated elements from the claim. The courts have determined that elimination of element renders the claim obvious. See In re Karlson, 136, USPQ 184 (CCPA 1963); In re Wilson, 153 USPQ 740 (CCPA 1967); Ex parte Rainu, 168 USPQ 375 (PTO Bd. Of App. 1969).

**Regarding independent claim 8**, Gauthier claim 15 teaches designating a path defined in a page description language specification as a wrapping path, the wrapping page having a boundary; defining graphics state for the path; processing the specification to produce a template bitmap, the template bitmap being a bitmap or raster-data representation of a template image defined by the specification; associating a text block with the wrapping path; creating bitmap representation of the block of text by applying graphics state to the block of text; merging the bitmap representation of the text, according to the boundary and according to the predefined flow rule, into the template bitmap (see Gauthier claim 15; compare with pending claim 8).

Gauthier does not explicitly teach plurality of words. However, this element would have been obvious to one of ordinary skill in the art at the time of the invention, because words within Gauthier PDL environment suggest bitmap words as words.

Gauthier does not explicitly teach replacing all occurrences of a predetermined word in the text block with a substitute word. Official Notice is given that replacing a word with a substitute word is well known in the art at the time the invention.

**Regarding independent claim 9 (and dependent claims 10-11), Gauthier claim 15** teaches designating a path defined in a page description language specification as a wrapping path, the wrapping page having a boundary; defining graphics state for the path; processing the specification to produce a template bitmap, the template bitmap being a bitmap or raster-data representation of a template image defined by the specification; associating a text block with the wrapping path; creating bitmap representation of the block of text by applying graphics state to the block of text; merging the bitmap representation of the text, according to the boundary and according to the predefined flow rule, into the template bitmap (see Gauthier claim 15; compare with pending claim 9).

Gauthier does not explicitly teach plurality of words. However, this element would have been obvious to one of ordinary skill in the art at the time of the invention, because words within Gauthier PDL environment suggest bitmap words as words.

Gauthier does not explicitly teach a delimiter. However, this element would have been obvious to one of ordinary skill in the art at the time of the invention, because a delimiter within Gauthier PDL environment suggests separating characters with a space, tab, and new line as delimiters.

**Regarding independent claim 12, Gauthier claim 15** teaches designating a path defined in a page description language specification as a wrapping path, the wrapping page having a boundary; defining graphics state for the path; processing the specification to produce a template bitmap, the template bitmap being a bitmap or raster-data representation of a template image defined by the specification; saving the template bitmap in memory; associating a text block with the wrapping path; creating bitmap representation of the block of text by applying graphics state

to the block of text; retrieving a copy of the template bitmap from memory; merging the bitmap representation of the text, according to the boundary and according to the predefined flow rule, into the template bitmap (see Gauthier claim 15; compare with pending claim 12).

Gauthier claim 16 teaches retrieving a next copy of the template bitmap from memory; merging the bitmap representations of the block of text, according to the boundary and according to the predefined flow rule, into the next copy of the template (see Gauthier claim 16; compare with pending claim 12).

Gauthier does not explicitly teach first copy of the template bitmap. It would have been obvious to one of ordinary skill in the art at the time the invention to implement “copy of the template bitmap” of Gauthier as “first copy of the template bitmap” of the instant application because “first copy of the template bitmap” is a narrower limitation. As such, by eliminating “copy of the template bitmap”, and relying instead on “first copy of the template bitmap”, a much narrower limitation, applicant has in effect eliminated elements from the claim. The courts have determined that elimination of element renders the claim obvious. See In re Karlson, 136, USPQ 184 (CCPA 1963); In re Wilson, 153 USPQ 740 (CCPA 1967); Ex parte Rainu, 168 USPQ 375 (PTO Bd. Of App. 1969).

**Regarding independent claim 13 (dependent claims 14-15),** Gauthier claims 11, 15, and 19 teaches defining graphics state for the path (Gauthier claim 15; compare to pending claim 13); the graphics state including at least one print attribute which controls the appearance of the data (Gauthier claim 19; compare with pending claim 13); monitoring text string defined in the data area for a special character or special string of characters (Gauthier claim 11, compare with pending claim 13); responsive to a detection of the special character or the special string of

characters in the text string, identifying the path defined by the page description language path command and having predetermined relationship with the data area as being associated with the wrapping command, the path having a boundary (see Gauthier claim 11; compare with pending claim 13) storing the graphics state corresponding to the data area in memory (see Gauthier claim 19; compare with pending claim 13); associating a block of text with the wrapping command (see Gauthier claim 19, compare with pending claim 13); applying the stored graphics state to the block of text to generate bitmap representations of the block of text (see Gauthier claim 15; compare with pending claim 13); merging the bitmap representation of the text, according to the boundary and according to the predefined flow rule (see Gauthier claim 19; compare with pending claim 13).

Gauthier does not explicitly teach accessing a data area defined in the page description language specification. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, because a data area within Gauthier PDL environment suggests an area defined in PDL specification for a document as the data area.

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Almari Yuan whose telephone number is (703) 305-5945. The examiner can normally be reached on Mondays - Fridays (8:30am - 5:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

AY  
September 16, 2003

  
SANJIV SHAH  
PRIMARY EXAMINER